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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,370	05/11/2001	Donald S. Gardner	42390P11265	7273

8791 7590 10/23/2002

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EXAMINER

NGUYEN, TUYEN T

ART UNIT	PAPER NUMBER
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2832

DATE MAILED: 10/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/853,370

Applicant(s)
Gardner

Examiner
Tuyen T. Nguyen

Art Unit
2832



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 12, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above, claim(s) 12-15 and 31-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 16-30, and 35-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 6) ☐ Other:

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DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of the restriction in Paper No. 7 is acknowledged. The traversal is on the ground(s) that claims 1-38 read on elected species of figures 1-10. This is not found persuasive because claims 12-15 and 31-34 are not shown by species elected.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 12-15 and 31-34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 16-19 and 35-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 16 and 35, applicant should clarify the specific positioning of the turns of the first conductor relative to the second conductor. The structure intended is unclear.

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Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

6. Claims 1, 6, 7, 10, 16-19, 20, 25-26, and 35-38, as best understood in view of the rejection under 112 second paragraph, are rejected under 35 U.S.C. 102(e) as being anticipated by Mizoguchi et al. [US 6,404,317].

Mizoguchi et al. discloses a planar magnetic transformer [figures 21-24] comprising:

- a substrate [10];
- a first conductor [40A] mounted over the substrate defining a generally spiral-shaped signal path having at least one turn;
- a second conductor [40B] mounted over the substrate defining generally spiral-shaped signal path having at least one turn, wherein the second conductor lies over the first conductor;
- a first magnetic layer [30A] disposed between the substrate and the first conductor; and
- a second magnetic layer [30B] disposed over both the first and second conductors.

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Regarding claims 20, 25-26 and 35-38, the method steps claimed would have been inherent in the product structure.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-5, and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizoguchi et al. in view of Fessant et al. [IEEE paper, copyrighted 1993].

Mizoguchi et al. discloses the instant claimed invention except for the specific material use for the magnetic layer.

Fessant et al. discloses the use of amorphous CoZr thin films.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the materials shown by Fessant et al. for the magnetic layers of Mizoguchi et al. for the purpose of providing low coercitivity.

Regarding claims 21-24, the method steps claimed would have been inherent in the product structure.

9. Claims 8, 9, 11 and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizoguchi et al. in view of Takaya et al. [US 5,530,415].

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Mizoguchi et al. discloses the instant claimed invention except for a magnetic layer disposed between the first and second conductors.

Takaya et al. discloses a stacked layer inductor [prior art figures 98 and 99] having a plurality of conductor layers [32, 35] and a magnetic layer [34] disposed therebetween.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the magnetic layer arrangement of Takaya et al. in Mizoguchi et al. for the purpose of controlling the magnetic flux.

Regarding claims 27-30, the method steps claimed would have been inherent in the product structure.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Tuyen T. Nguyen whose telephone number is (703) 308-0821.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Elvin Enad, can be reached at (703) 308-7619. The fax number for this Group is (703)872-9318 before the final office action, if the response is after final office action the fax number is (703)872-9319.

Any inquiry of a general nature or relating to status of this application of proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

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October 20, 2002

Truyen T. Nguyen